

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s):	Niemi, et al.	CONF. No.:	4430
SERIAL NO.:	09/920,057	ART UNIT:	2137
FILING DATE:	8/1/2001	EXAMINER:	Davis, Zachary A.
TITLE:	DATA TRANSMISSION METHOD, USER EQUIPMENT AND GPRS/EDGE RADIO ACCESS NETWORK		
ATTORNEY DOCKET NO.:	324-010477-US (PAR)		

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE REVIEW

This is in response to the Final Office Action mailed 16 October 2006 in regard to the above-identified patent application. A Notice of Appeal is being filed herewith together with a petition for a one-month extension of time.

Claims 1-8, 11, 12, 17-24, 27, 28, 33-40, 43 and 44 are rejected under 35 U.S.C. §102(a) or (e) as being anticipated by Fauconnier. Applicant respectfully submits that this rejection is incorrect because (1) the filing date of Falconnier is 21 May 2001, which is subsequent to Applicant's earliest priority date; and (2) the portion of the referenced 3GPP specification relied upon only discusses handover scenarios, which are admitted to be speculative. Thus, Fauconnier cannot be used to, and in any event does not, anticipate Applicant's claims.

The priority date of Fauconnier is subsequent to Applicant's earliest priority date. Applicant's earliest priority date of record is August 1, 2000. Fauconnier's priority date is 21 May 2001, which is clearly subsequent to Applicant's filing date. Thus, Fauconnier does not qualify as a prior art reference against Applicant's claimed invention.

The Examiner refers to the teachings of Fauconnier, as disclosing the features claimed by Applicant. See e.g. in the Office Action mailed October 16, 2006, page 4, second full paragraph, and page 5, paragraphs 1-5. Since Fauconnier's priority date is subsequent to Applicant's priority date, Fauconnier is not prior art, and its use in this action is procedurally improper and clear error.

A prior art reference is exactly that "prior" art. Fauconnier is not "prior" art since its earliest priority date is after Applicant's earliest date of record. The patent laws are quite clear that in order for a reference to qualify as a prior art teaching, the cited reference must have a priority date that precedes the priority date of Applicant's invention. (see e.g. MPEP §706.02 et seq.)

The Examiner refers to 35 U.S.C. §§102(a) or 102(e) as the basis of anticipation over Fauconnier. However, 35 U.S.C. §102(a) clearly states that the invention must be patented or described in a printed publication "before the invention thereof by the applicant for patent." 35 U.S.C. §102(e) also states that the invention must be described in an application by another filed in the United States "before" the invention by the applicant for patent, or a patent granted on an application filed "before" the invention by applicant.

The Examiner states that Fauconnier refers back to certain technical specifications that disclose the features claimed by Applicant. Applicant submits that this is procedurally and technically incorrect.

The relevant statutes indicate the reference must be “before” applicant’s invention. There is no provision for a reference that is after, or subsequent to Applicant’s earliest priority date. Thus, Fauconnier, and what is recited therein is not prior art against Applicant’s claimed inventions, and cannot be used for purposes of 35 U.S.C. §102(a) or §102(e) as set forth by the Examiner. Therefore, the Examiner’s use of Fauconnier is erroneous.

Furthermore, the portions of Fauconnier relied on by the Examiner do not disclose or suggest the features recited in Applicant’s claims. First, the Examiner primarily relies on citations directly from Fauconnier. Second, even where the Examiner refers to other references cited within Fauconnier, those references do not disclose or suggest the features claimed by Applicant. For example, the handover scenarios described in the 3GPP specification 3G TR 25.832 merely speculate on handover scenarios. Referring to, for example, the paragraph in Section 1, “Scope”, it is stated that the document identifies a number of handover and SRNS relocation scenarios for UTRAN. On page 5, section 5.7 entitled Intra CN (UTRAN-GSM/GPRS) it is stated that the “scenario shows handover between UTRAN and a GSM BBS.” It is further noted that the “ability of the GSM to support this scenario is for further study” and is “out of the scope for this report.” (see pg. 12).

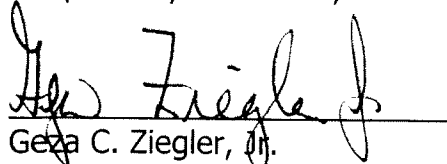
Thus, it is evident that the above comments relied on in these references are mere speculation and do not teach anything of a concrete nature let alone what is explicitly recited in Applicant’s claims. Any further application of this teaching, as proposed by the Examiner, is also speculative. A *prima facie* case of anticipation under 35 U.S.C. §102 requires that each and every feature recited by Applicant in the claims be explicitly taught by the cited reference. This is not the case here, and any suggestion to that effect can only be made with hindsight knowledge of Applicant’s claimed invention.

Thus, since Fauconnier does not qualify as prior art under 35 U.S.C. §102, it cannot be used to support a rejection of Applicant’s claims, and the rejection is clear error.

Additionally, the other references relied upon do not explicitly teach each and every element claimed by Applicant, and admit to being mere speculation. The Examiner's reliance on this "speculation" is improper, and can only be done with hindsight knowledge of what is claimed by Applicant.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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16 Feb 2007
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I hereby certify that this correspondence is being electronically on the date indicated below, addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date: 16 February 2007

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